

### **REMARKS**

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. With this amendment, claims 1 and 12 have been amended, no claims have been cancelled, and no claims have been added. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier. Thus, claims 1-3, 5, 7, 9-14, and 35-41 remain pending in the application.

Support for the amendments to claims 1 and 12 can be found in the disclosure in at least paragraph [0058] and Fig. 10 and previously presented claim 1. Note that although the word "permutation" is not explicitly recited in the specification, a permutation of labels is described in paragraph [0058]. If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991); *Martin v. Johnson*, 454 F.2d 746, 751, (CCPA 1972)(stating "the description need not be in *ipsis verbis* [i.e., "in the same words"] to be sufficient"). No new matter has been added.

### **Claim Rejections under 35 USC 112, second paragraph**

Claims 1-3, 5, 7, 9-11, 35, 37-39 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly

claim the subject matter which applicant regards as the invention. Specifically, claims 1-3, 5, 7, 9-11, 35, 37-39 and 41 were rejected because "Claim 1 does not recites binding of the at least one of the plurality of barcodes to a target." (Office action, page 3, lines 14-15). Applicants respectfully traverse the rejection.

Claim 1 has been amended to recite, *inter alia*, "binding the at least one of the plurality of the barcodes to a target." Support for this amendment can be found in previously presented claim 1. Applicants submit that amended claim 1 is definite and respectfully request withdrawal of the rejection.

**Claim Rejections under 35 USC 112, second paragraph**

Claims 1-3, 5, 7, 9-14 and 37-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cleve et al (Molecular and Cellular Probes 12:243-7, 1998, prior art of record) in view of Dimitrov et al (US 20031001 3091). Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cleve et al (Molecular and Cellular Probes 12:243-7, 1998, prior art of record) in view of Dimitrov et al (US 20031001 3091) as applied to claims 1-3, 5, 7, 9-14 and 37-41 above, and further in view of Hildebrandt et al (J. Phys. Chem., 1984, Vo1.88, pp.5935- 5944, prior art of record) and Maniatis et al (Molecular Cloning: A Laboratory Manual, Cold Spring Harbor Laboratory, 1982).

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). *See also* MPEP 2143.03. Claim 1 has been amended to recite, *inter alia*, "at least one of the plurality of the barcodes comprising a permutation of two or more different types of tags branched to an organic molecule backbone,

wherein each of the two or more different types of tags appear no more than once in the at least one of the plurality of barcodes.” Claim 12 has been amended to recite, *inter alia*, “the container section comprises a permutation of two or more different types of tags branched to the organic molecule backbone, wherein each of the two or more different types of tags appear no more than once in the container section.” These features are neither taught nor suggested by Cleve, Dimitrov, Hildebrandt, Maniatis, or any combination thereof.

The Examiner relies on Dimitrov for teaching “a method of generating “a large number of unique labels of about the same unit signal from just a small number of different labels.” (Office action, page 7, lines 3-5). None of the other references teach or suggest this feature. Dimitrov, however, teaches a method which requires varying the *ratio* of a small number of labels to make the large number of unique labels. (see paragraph [0073]). Indeed, in the example in paragraph [0073], Dimitrov teaches “The labeled nucleotides will be incorporated into the DNA in a unique ratio determined by the ratio of the two repeats. In this example, the end result is ten uniquely labeled nucleic acids where the set ratio of the two fluorophores is 1:10, 2:9, 3:8, 4:7, 5:6, 6:5, 7:4, 8:3, 9:2, and 10:1.” Thus, Dimitrov teaches completely different labels from those recited in amended claims 1 and 12. Further, any combination of references with Dimitrov would also result in barcodes comprising *ratios* of labels, not “a permutation” “wherein each of the two or more different types of tags appear no more than once” as recited in amended claims 1 and 12. Thus, no combination of Cleve, Dimitrov, Hildebrandt, and Maniatis would have rendered obvious amended claims 1 and 12 or

any of the claims that depend from these claims to one of ordinary skill in the art at the time of the invention. Applicants respectfully request withdrawal of the rejections.

### **CONCLUSION**

In view of the above amendment, applicant believes the pending application is in condition for allowance. The Director is authorized to charge any fees necessary and/or credit any overpayments to Deposit Account No. 03-3975, referencing Docket No. 043395-0377977.

Respectfully submitted,

Dated: September 10, 2009

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